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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,410	12/18/2001	Yoshiyuki Murata	01820/LH	3643
1933	7590	11/03/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			GODDARD, BRIAN D	
767 THIRD AVENUE			ART UNIT	
25TH FLOOR			PAPER NUMBER	
NEW YORK, NY 10017-2023			2161	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/023,410

Applicant(s)

MURATA, YOSHIYUKI

Examiner

Brian Goddard

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/13/2004</u> .                                                           | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 13 May 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, no English translation or explanation of relevance is included for the Korean Patent document KR 2000-0058503 A. All other documents cited on this disclosure statement have been considered.

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).

"Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A

"Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. The disclosure is objected to because the BRIEF SUMMARY OF THE INVENTION section [see (f) above] is missing and/or not properly designated by a heading. The examiner suggests that this heading be added to the specification at ¶ 0008 as this appears to be the beginning of the brief summary.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,683,611 to Cleveland.

Referring to claim 1, Cleveland discloses an electronic book data delivery apparatus as claimed. See Figures 2-13 and the corresponding portions of the specification for this disclosure. In particular, Cleveland teaches “an electronic book data delivery apparatus [See Figs. 2 & 13] comprising:

storage means [90 & 162] having stored a plurality of book data [customizable reading material (See all of disclosure, particularly Figs. 5 & 7-8)] each representing the content of an electronic book, a plurality of reciter images [See Fig. 12b] each for reading aloud the content of a book represented by a respective one of the plurality of

book data [See all Figures], and a plurality of voice data each representing a voice of a respective one of the plurality of reciter images [See Column 20, lines 22-39];

receiving means [See Figs. 5-12] for receiving a request for delivery of a selected one of the plurality of book data and at least one selected one of the plurality of reciter images for reading aloud the selected book data [also See Fig. 13] from an external electronic book device [See Column 20, line 4 – Column 21, line 10] via communicating means [164]; and

sending means [24], responsive to the request for delivery, for reading the selected book data, the at least one reciter image, and voice data representing the voice of the at least one reciter image from said storage means and for sending those data via the communication means to said external electronic book device [See Column 20, line 4 – Column 21, line 10]” as claimed.

Referring to claim 2, Cleveland teaches the electronic book data delivery apparatus of claim 1, as above, wherein the book data comprises a plurality of character images [See Figs. 9, 11 & 12a]...and said sending means comprises image sending means for sending...the images [See Column 20, line 4 – Column 21, line 10] as claimed.

Referring to claim 3, Cleveland teaches the electronic book data delivery apparatus of claim 1, as above, wherein said storage means comprises substorage means in which the plurality of reciter images and the plurality of character images appearing in the electronic book are stored in corresponding relationship [See Figs. 11-

12]; and said sending means comprises image sending means...[See claims 1 & 2 above] as claimed.

Referring to claim 4, Cleveland teaches the electronic book data delivery apparatus of claim 3, as above, wherein said character image sending means comprises voice data sending means...[See Column 20, line 4 – Column 21, line 10] as claimed.

Claim 5 is rejected on substantially the same basis as claims 1-4 above. See the discussions regarding claims 1-4 as well as the portions of Cleveland's specification cited therein for the details of this disclosure.

Referring to claim 6, Cleveland teaches the electronic book data delivery apparatus of claim 5, as above, further comprising price data receiving means...for receiving data on the price and/or a charge for delivery of the at least one reciter image and corresponding voice data [See Fig. 10] as claimed.

Referring to claims 7 and 8, Cleveland discloses the electronic book data delivery apparatus of claim 5, as above, further comprising publishing means [See Column 20, line 4 – Column 21, line 10]...as claimed. Also see the discussions regarding claims 2-4 above for details of this disclosure.

Claim 9 is rejected on substantially the same basis as claims 1-8 above. See the discussions regarding claims 1-8 as well as the portions of Cleveland's specification cited therein for the details of this disclosure.

Claim 10 is rejected on the same basis as claim 2, in light of the basis for claim 9. See the discussions regarding claims 1-8 as well as the portions of Cleveland's specification cited therein for the details of this disclosure.

Claims 11-19 are rejected on the same basis as claims 1-9 respectively. See the discussions regarding claims 1-9 above for the details of this disclosure.

Claim 20 is rejected on the same basis as claim 5. See the discussions regarding claims 1-5 above for the details of this disclosure.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Nos. 6,544,040 to Brelis et al. and 6,246,672 to Lumelsky, as well as U.S. Patent Application Publication No. 2001/0014895 to Sappal, are considered particularly pertinent to applicant's claimed invention.

The remaining prior art of record is considered pertinent to applicant's disclosure, and/or portions of applicant's claimed invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 571-272-4020. The examiner can normally be reached on M-F, 9 AM - 5 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg  
29 October 2004

  
SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER